

DOCKET NO.: USYS-0046



PATENT

#5/a  
B.D.  
4-2-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

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Confirmation No.: 8021

Steven Luzeski, and Barbara E. Osder

Serial No.: 09/363,339

Group Art Unit: 2645

Filing Date: July 29, 1999

Examiner: Simon P. Sing

For: VOICE MESSAGING SYSTEM WITH ENHANCED CUSTOMIZABILITY

DATE OF DEPOSIT:

3/21/03

I HEREBY CERTIFY THAT THIS PAPER IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL, POSTAGE PREPAID, ON THE DATE INDICATED ABOVE AND IS ADDRESSED TO THE COMMISSIONER OF PATENTS AND TRADEMARKS, WASHINGTON, DC 20231.

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PETITION FOR TWO MONTH EXTENSION OF TIME AND  
AMENDMENT AND RESPONSE TO OFFICE ACTION DATED OCTOBER 24, 2002

Commissioner for Patents  
Washington DC 20231

Sir:

PETITION FOR TWO MONTH EXTENSION OF TIME

Applicants hereby petition that the three-month period for response to the Examiner's

Action be extended for two (2) months to March 24, 2003.

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**AMENDMENT AND RESPONSE TO OFFICE ACTION  
PURSUANT TO 37 CFR § 1.111**

The present paper is submitted as a complete response to the Office Action dated October 24, 2002. Applicant respectfully requests consideration of the remarks herein below. Aside from the extension fees previously mentioned herein, no additional fees are believed due with the submission of this Amendment and Response to Office Action; however, should any additional fees be required, the Commissioner is authorized to deduct said fees from Woodcock Washburn LLP, Deposit Account No. 23-3050/USYS-0046.

**AMENDMENT**

**In The Claims**

Please amend Claims 1, 2, 7, 10, 11, 17, 18, 22, and 23; a clean copy of these amended claims is included in Attachment A hereto, and a marked-up version of the amended claims is included in Attachment B hereto.

**In The Drawings**

The drawings have been filed as a separate paper with a transmittal letter addressed to the Official Draftsperson with a request to correct the drawings as shown on the enclosed set of drawings sheets, herein as Attachment C.

**RESPONSE TO OFFICE ACTION****Overview of the Office Action**

Claims 1, 2, 7, 10, 11, 17, 18, 22, and 23 were rejected under 35 U.S.C. § 112. Claims 1-6, 8-15, and 17-24 were rejected under 35 U.S.C. § 102(b). Claims 7, 16, and 25 were rejected under 35 U.S.C. § 103(a).

**Status of the Claims/Amendments**

Claims 1, 2, 7, 10, 11, 17, 18, 22, and 23 have been amended. Claims 1-25 are pending.

**Claims Rejected Under 35 U.S.C. § 112****Regarding Claims 1, 2, 10, 11, 17, 18, 22, and 23:**

Claims 1, 2, 10, 11, 17, 18, 22, and 23 were rejected by the Examiner under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the Examiner notes that the Applicants claim a [software] module comprising call flows, and the Examiner contends that it is known in the art that a software program cannot comprise a call flow itself, but can only comprise the functions of a call flow. In response, Applicants have amended Claims 1, 2, 10, 11, 17, 18, 22, and 23 to replace the term “call flows” with the phrase “call flow functions”. In light of this amendment, and in regard to Claims 1, 2, 10, 11, 17, 18, 22, and 23, Applicants respectfully request that the rejections under § 112 be withdrawn.

**Regarding Claim 7:**

Claims 7 was rejected by the Examiner under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Specifically, the Examiner cited the use of the term “rapidly” in line 2 of Claim 7 as being indefinite. In response, Applicants have amended Claim 7 to replace the term “rapidly” with the phrase “within a predetermined period”. In light of this amendment, and in regard to Claim 7, Applicants respectfully request that this rejection under § 112 be withdrawn.

**Claims Rejected Under 35 U.S.C. § 102(b)**

Claims 1-6, 8-15, and 17-24 were rejected under 35 U.S.C. § 102(b) as being anticipated by Juster (U.S. Patent No. 5,724,406).

**Regarding Claims 1-6 and 8-15:**

In the Office Action, the Examiner contends that “Juster teaches using various call processing primitives (CPP) for customizing call process service (column 5, lines 12-32)” and that “Juster’s software [module] includes functions of call flows (column 5, lines 26-29), codes (a software comprises computer executable codes), and a list of names (names of variables, functions, users, etc.) and a modifiable list of corresponding DTMF signal identifier (column 5, lines 23-26).” However, the Applicants respectfully submit that Juster does not in fact teach the use of a modifiable list of corresponding DTMF signal identifiers.

Juster discloses an example of a call process service wherein “a user develops a voice mail messaging application having the necessary voice prompts and DTMF responses by

selecting appropriate CPPs that generate those prompts and tone responses” (column 5, lines 23-26). This disclosure seemingly suggests that a user of the Juster invention can select different CPPs to obtain different functionality. However, nowhere does Juster suggest that a user can actually modify a single CPP in a manner that specific DTMF signals corresponding to specific functionality for that specific CPP are thereby changed. On the contrary, Juster instead teaches away from a DTMF-modifiable CPP and instead suggests that a user must select a specific (or “appropriate”) CPP to achieve specific functionality, including DTMF mapping, which is predefined for each individual CPP. Consequently, the inability of a user to change the specific DTMF signals corresponding to specific functionality for a specific CPP in the invention of Juster requires a programmer must to first develop, for utilization by a user, a library of CPPs for each possible combination of DTMF signals mapped to specific CPP functionality from which the user can select the DTMF mapping desired.

In contrast, in Claim 1 of the present invention the Applicants have claimed “a module comprising call flows, code and a customization list; wherein the customization list comprises a table with a list of names and a modifiable list of corresponding DTMF signal identifiers, whereby *the particular customer is permitted to change the mapping between caller-entered DTMF signals and the corresponding actions taken by the messaging system by modifying the list of DTMF signal identifiers*” (emphasis added). This specific limitation, which enables a user to modify the specific DTMF signals corresponding to specific functionality for that specific module, precludes the need for a library of modules with various DTMF signal mapping, and thereby clearly differentiates the present invention from the invention of Juster.

For this reason, Applicants respectfully request that this rejection under § 102(b) be withdrawn and that Claim 1 be allowed to issue. Moreover, given that Claims 2-6 and 8-15 are dependent upon Claim 1, and given that claims dependent upon an allowable independent claim are themselves allowable, Applicants further request that Claims 2-6 and 8-15 also be allowed to issue.

**Regarding Claims 17-24:**

In Claim 17 of the present invention, the Applicants have claimed, as an element of the claim, “a messaging application comprising a module containing call flows, code and a customization list; wherein the customization list comprises a table with a list of names and a modifiable list of corresponding DTMF signal identifiers, whereby *a customer is permitted to change the mapping between caller-entered DTMF signals and the corresponding actions taken by the messaging system by modifying the list of DTMF signal identifiers*” (emphasis added). This specific limitation, which is similar to the corresponding limitation of Claim 1, enables a user to modify the specific DTMF signals corresponding to specific functionality for that specific module and thus precludes the need for a library of modules with various DTMF signal mapping. Juster, on the other hand, nowhere teaches the ability for a user to modify the DTMF signal mapping for a specific CPP (as discussed in detail earlier herein), and thus this specific limitation in Claim 17 clearly differentiates the present invention from the invention of Juster.

For this reason, Applicants respectfully request that this rejection under § 102(b) be withdrawn and that Claim 17 be allowed to issue. Moreover, given that Claims 18-24 are dependent upon Claim 17, and given that claims dependent upon an allowable independent claim are themselves allowable, Applicants further request that Claims 18-24 also be allowed to issue.

**Claims Rejected Under 35 U.S.C. § 103(a)****Regarding Claim 7:**

Claim 7 was rejected under 35 U.S.C. § 103(a) as being obvious over Juster in view of Weber (U.S. Patent No. 6,094,239).

In order to establish a prima facie case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally the prior art reference (or references when combined) must teach or suggest all the claim elements. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and cannot be based on applicant's disclosure. (MPEP §§ 2142, 2143.)

In regard to the third criteria, nowhere do Juster or Webber, separately or in combination, suggest or teach that that a user can actually modify a single CPP such that specific DTMF signals corresponding to specific functionality for that specific CPP are thereby changed. On the contrary, Juster instead teaches away from a DTMF-modifiable CPP and instead suggests that a user must select a specific (or "appropriate") CPP to achieve specific functionality which, including the DTMF mapping, is predefined for each individual CPP. Consequently, the inability of a user to change the specific DTMF signals corresponding to specific functionality for a specific CPP in the invention of Juster requires that a programmer must first develop, for utilization by a user, a library of CPPs for each possible combination of DTMF signals mapped

to specific CPP functionality from which the user can select the DTMF mapping desired.

Likewise, Webber lacks any teaching whatsoever on mapping of DTMF signals.

Furthermore, in regard to the first criteria for obviousness, Applicants respectfully submit that Juster and Webber lack any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify these references or to combine these reference teachings. In regard to Claim 7, the Examiner admits that "Juster fails to specifically teach that when two DTMF tone entered by a user withing a predetermined period, a double-digit list function (or event) is executed." The Applicants further submit that Juster nowhere identifies any challenges in detecting and processing multiple DTMF signals entered by a user to indicate a single selection, nor even acknowledges any need to differentiate between such and a single DTMF signal entered by a user to indicate a selection. Since Juster lacks any suggestion for the need of this form of functionality, Juster also lacks any suggestion or motivation to combine with the teachings of Webber on this point.

On the other hand, the invention of Webber discloses that "[w]hen the user keys-in a sequence of channel selection numbers, they must be entered quickly. For example, to select channel 36, the first entry number 3 is keyed-in and the second entry number 6 must also be immediately keyed-in, without a hesitation of more than a few seconds" (column 2, lines 8-12). However, the invention of Webber is specifically directed to "[a] handheld remote controller device" for "television receivers, video cassette recorders, satellite receivers and other consumer oriented entertainment apparatus" and nowhere suggests the application of its invention to other analogous technologies other than entertainment-based remote control devices, much less technologies in non-analogous arts such as the subject of the present invention. In fact, Webber



actually teaches away from any application of multiple key-in sequences to the art of the present invention by stating that "If too much time passes after the first number is keyed-in, the second entry will be ignored ...[and] the selection will be automatically returned to the channel which was already selected before the change was attempted." In other words, the remote control described by Webber specifically requires a two-key entry, and thereby effectively ignores two single-key entries (or more) that, by some measure of time between the two inputs, fail to constitute a single two-key entry. In contrast, the present invention, as well as the relevant art, anticipates one-key, two-key, and other multi-key entries to constitute a single input, and thus the issue addressed by the present invention is not analogous to the problem identified by Webber. Therefore, given the divergent art, the different shortcomings addressed, and the differentiated solutions employed by each Webber and the present invention, the Applicants respectfully submit that Webber also lacks a suggestion or motivation to combine with the teachings of non-analogous art in Juster.

Applicants respectfully submit neither Juster nor Webber, separately or in combination, teach or suggest all the claim elements of the present invention, nor is there any suggestion or motivation to combine with the teachings, and thus Applicants further submit that a finding of obviousness in regard to amended Claim 7 is unsupported by these references. For these reasons, Applicants respectfully request that the rejection of Claim 7 under § 103(a) be withdrawn and that Claim 7 be allowed to issue.

**Regarding Claims 16 and 25:**

Claims 16 and 25 were rejected under 35 U.S.C. § 103(a) as being obvious over Juster in view of Chencinski et al. (U.S. Patent No. 5,355,406).

In regard to the third criteria for obviousness previously discussed herein, nowhere do Juster or Chencinski, separately or in combination, suggest or teach that a user can actually modify a single CPP such that specific DTMF signals corresponding to specific functionality for that specific CPP are thereby changed. On the contrary, Juster instead teaches away from a DTMF-modifiable CPP and instead suggests that a user must select a specific (or "appropriate") CPP to achieve specific functionality which, including the DTMF mapping, is predefined for each individual CPP. Consequently, the inability of a user to change the specific DTMF signals corresponding to specific functionality for a specific CPP in the invention of Juster requires that a programmer must first develop, for utilization by a user, a library of CPPs for each possible combination of DTMF signals mapped to specific CPP functionality from which the user can select the DTMF mapping desired. Likewise, Chencinski lacks any teaching whatsoever on mapping of DTMF signals.

Applicants respectfully submit neither Juster nor Webber, separately or in combination, teach or suggest all the claim elements of the present invention. Therefore, Applicants respectfully request that the rejection of Claims 16 and 25 under § 103(a) be withdrawn and that these claims be allowed to issue.

### **CONCLUSION**

Based on the reasons and rationale set forth herein, Applicants respectfully submit that the rejections have been overcome and, accordingly, Applicants request that the claims be allowed to issue. Should the Examiner have any questions, comments, or suggestions that would

expedite the prosecution of the present case to allowance, Applicants' undersigned representative earnestly requests a telephone conference at (206) 332-1394.

Date: 3/21/03



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